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EXAMINER
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DENNISON, JERRY B

ART UNIT	PAPER NUMBER
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2143

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/28/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

09/709,234

Applicant(s)

BOULTER ET AL.

Examiner

J. Bret Dennison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/22/2007</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Action is in response to Application Number 09/709,234 received on 18 December 2006.
2. Claims 1-48 are presented for examination.
3. The prosecution of this case has been transferred to another Examiner. All corresponding communications should be directed to Examiner's contact information, provided below.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 18 December 2006 has been entered.

### ***Response to Arguments***

Applicant's arguments, see Applicant's Response, filed 18 December 2006, with respect to the rejection(s) of claim(s) 1-48 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of He et al. (U.S. 6,557,042).

***Information Disclosure Statement***

4. It should be noted that the applicant has submitted an exorbitant amount of prior art on numerous PTO-1449's which, on initial consideration, do not all appear to have relevancy or pertinence to the instant invention as claimed. The applicant is requested in response to this office action to point out which of these numerous prior art are pertinent or relevant to the patentability of the invention as claimed in this instant application. It should be noted that it would be advantageous to the applicant to provide a concise explanation of why each of the prior art is being submitted and how it is understood to be relevant. "Concise explanations are helpful to the Office, particularly where documents are lengthy and complex and applicant is aware of a section that is highly relevant to patentability or where a large number of documents are submitted and applicant is aware that one or more are highly relevant to patentability." (See MPEP 609 under subheading "A. CONTENT" and 37 CFR 1.98(b)(5)).

***Claim Interpretation***

5. Claims 1-48 recite clauses including the language, "whereby", these clauses simply showing an outcome of their preceding limitations (i.e. "performing a limitation, such that something occurs"). Any language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. See MPEP 2106, section II, subsection C for specific examples.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-48 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

7. Claims 1-48 are not limited to hardware-based embodiments. Claims 1 and 24 recite a method for broadcasting data streams, which can be implemented in software. Claims 11 and 35 recite a system including limitations, which can be implemented in software (i.e. a database, a selection program). Claims 21 and 46 recite a user interface, which is simply a program and can be implemented in software. As such, the claims are not limited to statutory subject matter and are therefore non-statutory. See M.P.E.P. 2601.1 Section I, which states, "Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and USPTO personnel should treat a claim for a computer program, without the computer-readable medium needed to realize the computer program's functionality, as nonstatutory functional descriptive material."

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-12, 15, 17-36, 39, and 41-48 are rejected under 35 U.S.C. 102(e) as being anticipated by He et al. (U.S. 6,557,042).

8. Regarding claims 1 and 24, He et al. disclosed a multimedia summary generation system employing user feedback in which a multimedia server provides multimedia content, as well as summaries of the multimedia content, to one or more client computers. Each of the client computers is identified as being part of a particular group and summaries are generated for each group, the summaries including those portions of multimedia content that are most interesting to users of that group. The summaries are continually updated as each user is presented with the multimedia content and/or a summary of the content. Feedback from each user is collected and used to further refine the summary (He, col. 2, lines 20-40). He disclosed the data streams being stored in a database (He, col. 3, line 43).

Therefore, He disclosed a method for broadcasting data streams through a computer network to a user's computer, the steps comprising:

providing a database of data streams (He, col. 3, line 43);

selecting a data stream from said database according to a selection method (He, col. 7, lines 25-30, He disclosed selecting data streams based on user/group interests);

transmitting one of said data streams to the user's computer (He, col. 2, lines 30-35, He disclosed the multimedia content and/or summaries of data streams presented to the user);

receiving feedback expressing a preference from the user regarding said transmitted data stream (He, col. 2, lines 35-40); and

updating said selection method to better reflect said preference of the user (He, col. 2, lines 35-40); whereby

data streams transmitted to the user are biased according to said preference (He, col. 2, lines 35-40).

Claim 24 includes limitations that are substantially similar to claim 1, further including said selection method taking into account excluded data streams indicated by the user as not to be transmitted. He clearly disclosed this functionality by providing the user with a button to indicate what portions are not important (He, Fig. 5, 330).

Therefore, claim 24 is rejected under the same rationale as claim 1.

9. Regarding claims 2 and 25, He disclosed the limitations, substantially as claimed, as described in claims 1 and 24, including:

said selection method including generating a transmission list of data streams to transmit to the user's computer (He, col. 10, line 20, He disclosed a summary list);

transmitting one of said listed data streams to the user's computer (He, col. 10, line 20, He disclosed a summary list that dictates the order in which the data streams are presented to the user); and

updating said list of data streams to better reflect said preference of the user (He, col. 10, lines 20-25, He disclosed the list being updated based on the user scores);  
whereby

data streams transmitted to the user are biased according to said preference (He, col. 10, lines 20-25, He disclosed the list being updated based on the user scores);.

10. Regarding claims 3 and 26, He disclosed the limitations, substantially as claimed, as described in claims 1 and 24, including:

receiving feedback expressing preferences from sources other than the user (He, col. 7, lines 40-45, He disclosed that an original presenter in the multimedia stream may identify what the segments should be, in the summary. See Abstract, He also disclosed that feedback is received from multiple users, each user being a source).

11. Regarding claims 4 and 27, He disclosed the limitations, substantially as claimed, as described in claims 3 and 26, including wherein the step of receiving preferences from sources other than the user further comprises:

receiving feedback expressing preferences from the group consisting of other users, commercial radio stations, and lists of popular songs (See Abstract, He disclosed that feedback is received from multiple users).



12. Regarding claims 5 and 28, He disclosed the limitations, substantially as claimed, as described in claims 1 and 24, including:

informing the user generally regarding said database and said data streams (He, col. 8, lines 26-28, He disclosed providing all of the summary information to the user);

querying the user as to data stream preference prior to generating an initial transmission list of data streams (He, col. 8, lines 28-29, Fig. 5, 328, 330, He disclosed the user providing feedback for particular sets of summary information); whereby

said initial list reflects general preferences of the user (He, col. 8, lines 29-31).

13. Regarding claims 6 and 29, He disclosed the limitations, substantially as claimed, as described in claims 1 and 24, including wherein said data streams are selected from the group consisting of songs and video (He, col. 3, line 40).

14. Regarding claims 7 and 30, He disclosed the limitations, substantially as claimed, as described in claims 2 and 25, including wherein said transmitted data stream is removed from said transmission list (He, col. 9, line 65 through col. 10, line 5, He disclosed filtering the data streams based on scores, which are generated from user feedback. Therefore, if the user's feedback puts the score below a threshold, the data stream is removed).

15. Regarding claims 8 and 31, He disclosed the limitations, substantially as claimed, as described in claims 7 and 30, including wherein said data stream removed from said

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transmission list is listed on a transmitted data stream list (He, col. 13, lines 35-45, He disclosed all user feedback being stored. Based on the user feedback and score of the stream, it can be determined if the stream has been removed and already transmitted).

16. Regarding claims 9 and 32, He disclosed the limitations, substantially as claimed, as described in claims 1 and 24, including wherein said step of transmitting one of said data streams further comprises transmitting said one of said data streams in conformance with applicable copyright law (He, col. 13, line 15, He disclosed providing copyright information).

17. Regarding claims 10 and 33, He disclosed the limitations, substantially as claimed, as described in claims 9 and 32, including wherein said conformance with applicable copyright law applies to all transmitted datastreams (He, col. 13, line 15, He disclosed providing copyright information).

18. Regarding claim 34, He disclosed the limitations, substantially as claimed, as described in claims 24, including wherein said updated selection method takes into account all preferences expressed by said user (Fig. 5, 328, 330).

19. Regarding claims 11 and 35, He et al. disclosed a multimedia summary generation system employing user feedback in which a multimedia server provides multimedia content, as well as summaries of the multimedia content, to one or more

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client computers. Each of the client computers is identified as being part of a particular group and summaries are generated for each group, the summaries including those portions of multimedia content that are most interesting to users of that group. The summaries are continually updated as each user is presented with the multimedia content and/or a summary of the content. Feedback from each user is collected and used to further refine the summary (He, col. 2, lines 20-40). He disclosed the data streams being stored in a database (He, col. 3, line 43).

Therefore, He disclosed a data stream system for providing preferred data streams to a user, comprising:

- a connection to a computer network, said computer network connected to a computer of the user (He, col. 2, lines 18-23);

- a database of data streams, said database available to said computer network (He, col. 3, lines 42-47);

- a data stream controller, said data stream controller transmitting data streams from said database to said user's computer according to a selection program (He, col. 2, lines 254-35, He disclosed transmitting the data streams according to group interests);

- a user interface, said user interface coupled to said user's computer and receiving said data streams for the user and providing a feedback mechanism for the user so that the user may indicate a preference regarding data streams transmitted by said data stream controller (He, col. 2, lines 35-41, 53-63, Fig. 5, 328, 330);

said selection program receiving indications from the user, said selection program modifying its selection of data streams for transmission to said user's computer according to said user preference (He, col. 2, lines 35-40); whereby data streams selected by said selection program are biased according to said user preference (He, col. 2, lines 35-40).

Claim 35 includes limitations that are substantially similar to claim 11, further including said selection program taking into account excluded data streams indicated by the user as not to be transmitted. He clearly disclosed this functionality by providing the user with a button to indicate what portions are not important (He, Fig. 5, 330). Therefore, claim 35 is rejected under the same rationale.

20. Regarding claims 12 and 36, He disclosed the limitations, substantially as claimed, as described in claims 11 and 35, including wherein said computer network comprises the Internet (He, Fig. 1, 110).

21. Regarding claims 15 and 39, He disclosed the limitations, substantially as claimed, as described in claims 11 and 35, including wherein said user interface comprises an electronic media player (Fig. 5, 302).

22. Regarding claims 17 and 41, He disclosed the limitations, substantially as claimed, as described in claims 11 and 35, including wherein said selection program creates a list of data streams for transmission to the user (He, col. 10, lines 20-25).

23. Regarding claims 18 and 42, He disclosed the limitations, substantially as claimed, as described in claims 17 and 41, including wherein said selection program modifies said list of data streams for transmission to the user according to said user preference (He, col. 10, lines 20-25).

24. Regarding claims 19 and 43, He disclosed the limitations, substantially as claimed, as described in claims 11 and 35, including:

said data stream controller transmitting said data streams in compliance with applicable copyright law (He, col. 13, line 15).

25. Regarding claims 20 and 44, He disclosed the limitations, substantially as claimed, as described in claims 19 and 43, including:

said data stream controller transmitting all data streams in compliance with applicable copyright law (He, col. 13, line 15).

26. Regarding claim 45, He disclosed the limitations, substantially as claimed, as described in claim 35, including wherein said selection program method takes into account all preferences expressed by said user (He, Fig. 5, 328, 330).

27. Regarding claims 21 and 46, He et al. disclosed a multimedia summary generation system employing user feedback in which a multimedia server provides

multimedia content, as well as summaries of the multimedia content, to one or more client computers. Each of the client computers is identified as being part of a particular group and summaries are generated for each group, the summaries including those portions of multimedia content that are most interesting to users of that group. The summaries are continually updated as each user is presented with the multimedia content and/or a summary of the content. Feedback from each user is collected and used to further refine the summary (He, col. 2, lines 20-40). He disclosed the data streams being stored in a database (He, col. 3, line 43).

Therefore, He disclosed a user interface (He, Fig. 5) for an Internet data stream transmission system, comprising:

- a media player, said media player playing data streams (He, Fig. 5, 302);

- a rating tool, said rating tool indicating a rating for a data stream currently played by said media player (He, Fig. 5, 328, 330); and

- a data stream information display, said data stream information display displaying information for said data stream currently played by said media player (He, Fig. 5, 334); whereby

- a user can indicate a preference regarding said data stream currently played by said media player (He, Fig. 5, 328, 330).

Claim 46 includes limitations that are substantially similar to claim 21, further including said rating tool enabling exclusion of said data stream. He clearly disclosed this functionality by providing the user with a button to indicate what portions are not important (He, Fig. 5, 330). Therefore, claim 46 is rejected under the same rationale.

28. Regarding claims 22 and 47, He disclosed the limitations, substantially as claimed, as described in claims 21 and 46, including:

a playlist generator, said playlist generator generating playlists of data streams for said media player, said playlist generator selecting data streams according to preferences indicated by said user (He, col. 10, lines 20-25).

29. Regarding claims 23 and 48, He disclosed the limitations, substantially as claimed, as described in claims 22 and 47, including:

said data streams selected by said playlist generator being in compliance with applicable copyright law (He, col. 13, line 15).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13, 14, 16, 37, 38, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over He et al. (U.S. 6,557,042).

30. Regarding claims 13, 14, 37, and 38, He disclosed the limitations, substantially as claimed, as described in claims 11 and 35, including wherein said database contains audio data streams and video data streams (He, col. 3, line 40).

He did not explicitly state specific types of audio to use with the system.

This would have motivated one of ordinary skill to use well-known types of audio and video data streams. It was within the knowledge of one of ordinary skill in the art at the time the invention was made that a song is a well-known form of audio and a music video is a well-known type of video. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the database of He as a song database holding song data streams or a music video database holding music video data streams since both songs and music videos were standard forms of audio and video that were streamed across the internet.

31. Regarding claims 16 and 40, He disclosed the limitations, substantially as claimed, as described in claims 15 and 39.

He did not explicitly state specific types of media players that could be used with the system.

This would have motivated one of ordinary skill to use well-known media players. As shown in Applicant's instant specification, "RealNetworks' RealMedia, Apple QuickTime, and Windows Media all provide players through which live or previously-recorded data streams can be displayed, played back, or broadcast to the individual user" (See Applicant's instant Specification, page 2, lines 19-22).



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Since these media players (i.e. RealPlayer, Apple QuickTime, and Windows Media Player) were available at the time the invention was made, it would have been obvious to one of ordinary skill in the art to use one of them since they were publicly available, thereby saving time by not having to reinvent the wheel.

### ***Conclusion***

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

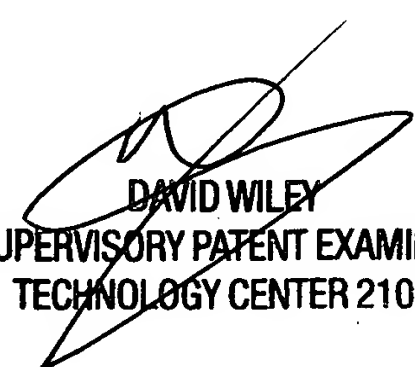
Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



J. B. D.  
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